REMARKS/ARGUMENTS

Claims 1-8, 10-33, 35-48, 50, 51 and 53-55 are pending in the application. The Examiner has rejected claims 1-8, 10-33, 35-48, 50, 51, 53 and 54. The Examiner has allowed claim 55. Applicant respectfully requests reconsideration of pending claims 1-8, 10-33, 35-48, 50, 51, 53 and 54.

The Examiner has rejected claims 1-8, 10-33, 35-48, 50, 51 and 53 under 35 U.S.C. § 101, alleging the claimed invention is directed to non-statutory subject matter. Applicant respectfully disagrees.

Regarding claims 1-8, 10-33, 35-48, 50, 51 and 53, the Examiner states, "The test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, *or* (2) transforms a particular article to a different state or thing. This is called the 'machine-or-transformation test.' See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)." Applicant has previously submitted argument, but the Examiner, in the Examiner's Response to Arguments, merely states, "Argument is moot." Applicant submits the Examiner also appears to misconstrue the Federal Circuit's opinion in *In re Bilski*. The Examiner states, "In order to overcome the 101 rejection, such claimed methods need to be tied to a particular machine or apparatus." Applicant submits such a requirement is inconsistent to what the Examiner has referred to as the "machine-or-transformation test." In Applicant's response to the final Office action, filed June 24, 2010, Applicant noted Applicant expected an opinion of the Supreme Court of the United States in *In re Bilski* to be soon forthcoming. Applicant notes, on June 28, 2010, the Supreme Court of the United States decided *In re Bilski*, 561 U.S. ___ (2010). Applicant notes Justice Kennedy, in delivering the opinion of the court, wrote "The Court of Appeals ruled that the first mentioned of these, the so-called machine-or-transformation test, was the sole test to be used for determining the patentability of a 'process' under the Patent Act, 35 U.S.C. §101." Justice Kennedy also wrote as follows:

> Adopting the machine-or-transformation test as the sole test for what constitutes a "process" (as opposed to just an important and useful clue) violates these statutory interpretation principles. Section 100(b) provides that "[t]he term 'process' means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material." The Court is unaware of any "'ordinary, contemporary, common meaning,'" *Diehr, supra*, at 182, of the definitional terms "process, art or method" that would require these terms to be tied to a machine or to a transform an article.

Justice Kennedy further wrote, "The Court of Appeals incorrectly concluded that this Court has endorsed the machine-or-transformation test as the exclusive test." As the Examiner expressly relies

upon the "machine-or-transformation test as the exclusive test," with the Examiner stating, "The test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, *or* (2) transforms a particular article to a different state or thing. This is called the 'machine-or-transformation test.' See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)," Applicant submits the rejection of claims 1-8, 10-33, 35-48, 50, 51 and 53 under 35 U.S.C. § 101 is contrary to Supreme Court precedent. *In re Bilski*, 561 U.S. ___ (2010). Therefore, Applicant submits claims 1-8, 10-33, 35, and 36 recite patentable subject matter and are in condition for allowance.

Moreover, Applicant has amended claims 1, 37, and 45. Applicant submits such amendments are supported by the specification, as originally filed, for example, paragraph [0013]. Thus, Applicant submits no new matter has been added. Therefore, Applicant submits claims 1-8, 10-33, 35, and 36 recite patentable subject matter and are in condition for allowance.

The Examiner has rejected claims 1-8, 10-33, 35 and 36 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully disagrees. Applicant submits the Examiner appears to be mischaracterizing the subject matter of claim 1. The Examiner states, "As such, identification of failure is not based on protection switching priority." The Examiner states, "Rather, protection switching priority is determined after identification of the failure." Applicant notes claim 1 does not recite "identification of failure" or "identification of the failure," but rather "...wherein identifying the failure predicted one of said protected system elements includes...." Thus, Applicant submits the Examiner's purported rationale for the § 112, first paragraph, rejection is inapplicable. Therefore, Applicant submits claims 1-8, 10-33, 35, and 36 comply with the written description requirement and are in condition for allowance.

In the advisory action, the Examiner states as follows:

> In response to applicant's argument pertaining to 112 1st rejection (see bottom of page 15), "Applicant notes claim 1 does not recite 'identification of failure' or 'identification of the failure,' but rather '...wherein identifying the failure predicted one of said protected system elements includes...," applicant has failed to show support for "identifying the failure" or "assessing performance" being at least partially based on a protection switching priority. The specification discloses "...when a plurality of failure predicted cards have been identified, an operation 120 is performed for determining a protection switching priority among the plurality of failure predicted cards" (see paragraph 18). As such, the specification only shows support for protection switch priority being determined after "identifying of the failure."

Applicant respectfully disagrees. Applicant notes the first sentence of the following paragraph, paragraph [0019], states, "The protection switching priority designates which one of a plurality of

failure predicted cards (i.e., the designated failure predicted card) will be subjected next to a protection switching operation." Thus, Applicant submits the specification contains a written description that obviates the § 112, first paragraph, rejection. Therefore, Applicant submits claims 1-8, 10-33, 35, and 36 comply with the written description requirement and are in condition for allowance.

The Examiner has rejected claims 37, 42, 44-48, 50 and 51 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,978,398 of Harper '398 in view of U.S. Patent No. 4,245,342 of Entenman.

With respect to claim 37, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper is concerned with failing over nodes for preventing degradation of performance (see figure 5b; column 1 lines 62-65, column 2 lines 23-26, and column 6 lines 39-42), and allotting a spare device among the devices in accordance with a priority algorithm, as per teachings of Entenman (see column 6 lines 38-42), constitutes as suitable known means for failing over nodes that further enables recovery of higher priority device." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342 and Harper et al. '398 references, Applicant notes such references are classified in different U.S. classifications and appear to have been subjected to mutually exclusive fields of search. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has not cited any portion of any of the cited references with respect to the Examiner's allegation of "...constitutes as suitable known means for failing over nodes that further enables recovery of higher priority device." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 37.

Regarding claim 37, Applicant submits the cited portions of the cited references fail to render unpatentable the subject matter of claim 37. For example, Applicant submits the teaching of column 6, lines 38-42, of the Entenman reference fails to disclose or render obvious "determining that a

protection switching priority among a collection of failure predicted system elements applies to the failure predicted one of said protected system elements." As an example, Applicant submits the cited portion of the cited reference does not disclose or render obvious "a collection of failure predicted system elements" or "the failure predicted one of said protected system elements."

In the Examiner's Response to Arguments, the Examiner states, "Harper discloses...." However, in relation to "determining that a protection switching priority among a collection of failure predicted system elements applies to the failure predicted one of said protected system elements," the Examiner states, in the rejection, "However, Harper '398 fails to explicitly disclose: determining that a protection switching priority among a collection of failure predicted system elements applies to the failure predicted one of said protected system elements, wherein downloading said service information is performed after determining that the protection switching priority applies to the failure predicted on of said protected system elements." The Examiner cites only "(see column 6 lines 38-42)" of the Entenman reference as allegedly disclosing "in case of multiple failures, allotting a spare device among the devices in accordance with a priority algorithm." As the Examiner has not cited any teaching from the Harper reference as to the "determining..." feature of claim 37 in rejecting claim 37 and has, in fact, acknowledged "Harper '398 fails to explicitly disclose: determining...," Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 37.

Moreover, Applicant submits the Examiner, in the Examiner's Response to Arguments, states, "Harper discloses in a cluster system having more than two nodes, the secondary node may not know which primary node is going to fail (see column 4 lines 23-27)...." Applicant submits such teaching teaches away from "determining that a protection switching priority among a collection of failure predicted system elements applies to the failure predicted one of said protected system elements, wherein downloading said service information is performed after determining that the protection switching priority applies to the failure predicted on of said protected system elements." Thus, Applicant submits it would not have been obvious for one of ordinary skill in the art to combine the alleged teachings of the cited portions of the cited references.

As another example, Applicant submits the teaching of column 2, lines 23-26, of the Harper et al. '398 reference does not disclose or render obvious "wherein downloading said service information is performed after determining that the protection switching priority applies to the failure predicted one of said protected system elements." Moreover, Applicant submits the teaching of column 6, lines 38-

42, of the Entenman reference does not disclose or render obvious "wherein downloading said service information is performed after determining that the protection switching priority applies to the failure predicted one of said protected system elements." Thus, Applicant submits even an attempted combination of the teachings of the cited references would not render such feature obvious. Applicant notes the Examiner offers no explanation as to why such alleged combination would supposedly render such feature obvious, but merely states, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings...." The Examiner alleges as motivation to combine the teachings that "Harper is concerned with degradation of performance (see column 1 lines 60-61). However, Applicant notes column 1, lines 60-61, of the Harper et al. '398 reference states "method and structure in which outage times of computer systems can be proactively reduced." Furthermore, the Examiner states, "as per teachings of Entenman (see column 6 line 38-42), constitutes as suitable known means for overcoming performance degradation by enabling recovery to the highest priority device." However, as Applicant sees no teaching in the cited portions of the Entenman reference of proactively reducing outage times of computer systems," Applicant submits the cited teachings of the Entenman reference do not constitute a suitable known means for proactively reducing outage times of computer systems, so Applicant submits the Examiner's alleged motivation to combine and even other variations of it are inapplicable to the teachings of the cited prior art references. Therefore, Applicant submits claim 37 is in condition for allowance.

In the Examiner's Response to Arguments, the Examiner alleges "...Entenman discloses in case of multiple failures, allotting a spare device among the devices in accordance with a priority algorithm (see column 6 lines 38-42), thus indicating a switching priority." The Examiner concludes "In combination with Harper who discloses downloading service information (see column 2 lines 23-26), the claim limitations are met." However, Applicant submits, even if what the Examiner alleges were borne out by the teachings of the references, it cannot be concluded that "the claim limitations are met." As an example, nothing the Examiner cites or alleges appears to teach or suggest "...is performed after determining...," as set forth in claim 37. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 37. Therefore, Applicant submits claim 37 is in condition for allowance.

As to the lack of suggestion to combine the references, in the rejection of the non-final Office action preceding the final Office action, the Examiner stated, "...Harper is concerned with degradation of performance (see column 1 lines 60-61)...." Now, however, the Examiner has changed that to read

"Harper is concerned with failing over nodes for preventing degradation of performance (see figure 5b; column 1 lines 62-65, column 2 lines 23-26, and column 6 lines 39-42), and allotting a spare device among the devices in accordance with a priority algorithm, as per teachings of Entenman (see column 6 lines 38-42)...." Thus, Applicant submits the Examiner's characterization of the cited prior art is in conflict with the Examiner's previous characterization. Moreover, as the Examiner has changed the rejection, Applicant respectfully requests the Examiner withdraw the finality of the Office action and issue a non-final Office action. Accordingly, Applicant submits the Examiner has not established teaching, suggestion, or motivation to combine or modify the teachings of the cited references. Therefore, Applicant submits claims 37 and 45 are in condition for allowance.

Regarding claim 42, Applicant submits the cited portion of the Harper et al. '398 reference teaches away from the subject matter of claim 42. For example, Applicant notes column 9, lines 16-17, state "...prior to said degradation in performance...," while Applicant notes claim 42 states, "...determining that the failure prediction parameter corresponding to a service agreement parameter for one of said protected system elements has declined...." Thus, Applicant submits the alleged teachings of the cited references cannot be combined to render obvious the subject matter of claim 42. Therefore, Applicant submits claim 42 is in condition for allowance.

In the Examiner's Response to Arguments, the Examiner cites "(see column 9 lines 10-15 and column 10 lines 12-15)" of the Harper '266 reference. Applicant notes "column 10 lines 12-15" of the Harper '266 reference states, "For example, it may be normal for paging traffic to quiesce, but if paging traffic quiesces and CPU utilization falls to zero, a hang may be indicated." Applicant submits the Examiner has not shown teaching as to "paging traffic" or "CPU utilization" disclosing or suggesting a "failure prediction parameter corresponding to a service agreement parameter." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 42. Therefore, Applicant submits claim 42 is in condition for allowance.

Regarding claim 44, Applicant notes the Examiner states "In regards to claim 44, Harper '398 in view of Entenman discloses the claim limitations as discussed above." While the Examiner cites "(see column 2 lines 23-26)," of the Harper et al. '398 reference, Applicant submits "...wherein there is other than a one-to-one relationship between the another node and the primary node" does not disclose or suggest "...wherein the protection system element provides switching functionality exclusively for

all of said protected system elements." Therefore, Applicant submits claim 44 is in condition for allowance.

In the Examiner's Response to Arguments, the Examiner states, "...Examiner has changed the claim to remove reference to Downes, thus making the specific rejection consistent with grounds of rejection above." Applicant notes the Examiner has changed the rejection, and Applicant respectfully requests the Examiner withdraw the finality of the Office action and issue a non-final Office action. Accordingly, Applicant submits the Examiner has not established teaching, suggestion, or motivation to combine or modify the teachings of the cited references. Thus, Applicant submits claim 44 is in condition for allowance.

With respect to claim 45, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper is concerned with failing over nodes for preventing degradation of performance (see figure 5b; column 1 lines 62-65, column 2 lines 23-26, and column 6 lines 39-42), and allotting a spare device among the devices in accordance with a priority algorithm, as per teachings of Entenman (see column 6 lines 38-42), constitutes as suitable known means for failing over nodes." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342 and Harper et al. '398 references, Applicant notes such references are classified in different U.S. classifications and appear to have been subjected to mutually exclusive fields of search. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has not cited any portion of any of the cited references with respect to the Examiner's allegation of "...constitutes as suitable known means for failing over nodes." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 45.

Regarding claim 45, Applicant submits the cited portions of the cited references fail to render unpatentable the subject matter of claim 45. As an example, Applicant submits the cited portions of

the cited references fail to render obvious "facilitating a failure confirmed protection switching operation in response to identifying that the failure prediction condition for one of said protected has been met during operation of said protected system elements." While the Examiner cites "(see column 6 lines 18-25)" of the Harper et al. '398 reference , Applicant notes the Examiner cited "(see column 2 lines 23-26)" with respect to "...wherein a failure prediction condition for at least a portion of a plurality of protected system elements is defined," and Applicant submits the teachings of column 6, lines 18-25, do not disclose or render obvious, for example, "...in response to identifying that the failure prediction condition for one of said protected has been met during operation of said protected system elements." Also, while the Examiner cites "(see column 4 lines 20-22 of incorporated by reference Harper '266)" as allegedly disclosing "facilitating an administrator-initiated protection switching operation in response to receiving an administrator-issued protection switching initiation notification," Applicant submits no teaching as to, for example, "...in response to receiving an administrator-issued protection switching initiation notification" is found in the cited portion. Also, as Applicant submitted with respect to claim 37 above, Applicant submits the Examiner's statement, "(as per teachings of Entenman (see column 6 lines 38-42), constitutes as suitable known means for overcoming performance degradation by enabling recovery to the highest priority device" mischaracterizes the subject matter of the cited portion of the cited reference. Thus, Applicant submits the Examiner's alleged motivation to combine is flawed. Therefore, Applicant submits claim 45 is in condition for allowance.

In the Examiner's Response to Arguments, the Examiner alleges teaching "indicating 'facilitating an administrator-initiated protection switching operation in response to receiving an administrator-issued protection switching initiation operations.'" However, Applicant submits claim 45 recites, in relevant part, "facilitating an administrator-initiated protection switching operation in response to receiving an administrator-issued protection switching initiation notification." Thus, Applicant submits the Examiner has not alleged teaching or suggestion as to the subject matter of claim 45. Accordingly, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 45. Therefore, Applicant submits claim 45 is in condition for allowance.

Regarding claim 46, Applicant submits the cited portions fail to render unpatentable the subject matter of claim 46. For example, while the Examiner cites "(see column 9 lines 7-14 of incorporated by reference Harper' 266)," Applicant submits neither the "single parameter measurement" nor the

"multiparameter measurement" of such portion appears to disclose or suggest "...for each of said protected system elements." Therefore, Applicant submits claim 46 is in condition for allowance.

In the Examiner's Response to Arguments, the Examiner cites "(see figure 5b and column 6 lines 39-42)." Applicant notes such portion states, "In contrast, FIG. 5B illustrates a 'one-to-many' relationship in the computer system between the secondary node 551B and the primary nodes 551A according to the present invention." Applicant submits the mere teaching of "a 'one-to-many' relationship in the computer system between the secondary node 551B and the primary nodes 551A" fails to disclose or suggest, for example, "specifying failure prediction criterion for each of said protected system elements." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 46. Therefore, Applicant submits claim 46 is in condition for allowance.

Regarding claim 47, Applicant submits the cited portion of the cited reference fails to render unpatentable the subject matter of claim 47. As an example, while the Examiner cites "(see column 9 lines 6-10 of incorporated by reference Harper '266)," Applicant submits the cited portion fails to disclose or suggest "...specifying a first type of failure prediction criterion for a first portion of said protected system elements and a second type of failure prediction criterion for a second portion of said protected system elements." Therefore, Applicant submits claim 47 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 47 is in condition for allowance.

Regarding claim 48, Applicant submits the cited portions of the cited reference fails to disclose the subject matter of claim 48. As an example, while the Examiner cites "(see column 4 lines 10-15 and column 6 lines 32-37)," Applicant submits neither of such portions discloses or renders obvious "...specifying said failure prediction criterion on a per protected system element basis." Therefore, Applicant submits claim 48 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests

the Examiner consider such arguments. Therefore, Applicant submits claim 48 is in condition for allowance.

Regarding claim 50, Applicant submits the cited portions fail to disclose or render obvious the subject matter of claim 50. As an example, while the Examiner cites "(see column 2 lines 23-26)" as allegedly disclosing "downloading service information of the failure predicted one of said protected system elements to the protection system element after identifying the failure predicted one of said protected system elements," Applicant submits "...wherein there is other than a one-to-one relationship between the another node and the primary node" does not teach or suggest "downloading service information of the failure predicted one of said protected system elements to the protection system element...." Therefore, Applicant submits claim 50 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 50 is in condition for allowance.

Regarding claim 51, Applicant submits the cited portion of the cited reference fails to disclose the subject matter of claim 51. As an example, while the Examiner cites "(see column 6 lines 38-42)" of the Entenman reference, Applicant notes that portion merely states, "In the arrangement of FIG. 2 microprocessor controlled apparatus is employed; and may allot the spare modem among the modules 10 in accordance with any desired priority algorithm (fixed or changing)." Applicant submits such teaching fails to disclose, for example, "...applies to the failure predicted one of said protected system elements prior to downloading said service information." Moreover, Applicant submits Entenman's teachings as to, for example, "...it is an object of the present invention to provide improved modem control apparatus which automatically operatively substitutes a redundant spare modem for any failed one of n active units..." of column 1, lines 11-14, teaches away from, for example, "...failure predicted system elements..." and "...the failure predicted one of said protected system elements...." Also, Applicant submits the cited portion fails to disclose or render obvious, for example, "...prior to downloading said service information." Therefore, Applicant submits claim 51 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests

the Examiner consider such arguments. Therefore, Applicant submits claim 51 is in condition for allowance.

The Examiner has rejected claims 1-3, 5, 6, 10, 12-23, 27, 29-33, 35, 36, 38, 40, 41 and 43 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,978,398 of Harper '398 in view of U.S. Patent No. 4,245,342 of Entenman and US Patent No. 4,769,761 of Downes et al.

With respect to claim 1, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper is concerned with failing over nodes (see column 2 lines 23-26; figure 5b and column 6 lines 39-42), and allotting a spare device among the devices in accordance with a priority algorithm, as per teachings of Entenman (see column 6 lines 38-42), constitutes as suitable known means for failing over nodes that further enables recovery of higher priority device." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342, Harper et al. '398, and Downes et al. '761 references, Applicant notes the Harper et al. '398 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has not cited any portion of any of the cited references with respect to the Examiner's allegation of "...constitutes as suitable known means for failing over nodes that further enables recovery of higher priority device." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 1.

With respect to claim 1, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper is concerned with detecting degradation of performance of a computer system (see column 1 lines 60-65), and monitoring the error count over a selected number of operations, as per teachings of Downes (see column 1 lines 60-65), constitutes as

suitable known means to detect degradation of performance of a computer system." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342, Harper et al. '398, and Downes et al. '761 references, Applicant notes the Harper et al. '398 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has not cited any portion of any of the cited references with respect to the Examiner's allegation of "...to detect degradation of performance of a computer system." Furthermore, while the Examiner cites "(see column 1 lines 60-65)" as to "Harper is concerned with detecting degradation of performance of a computer system," Applicant sees no teaching as to "detecting..." in the cited portion of the cited reference. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 1.

Furthermore, while the Examiner alleges "It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Harper, Entenman, and Downes...," Applicant note the Examiner alleges motivation only as combining "the teachings of Harper..., as per teachings of Downes." Thus, Applicant submits the alleged motivation does not appear to pertain to the alleged combination. Therefore, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 1.

Regarding claim 1, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 1. As an example, Applicant submits the cited portions of the cited references fail to disclose or suggest "wherein identifying the failure predicted one of said protected system elements includes assessing performance of said protected system elements based at least partially on an element demerit point level of each one of said protected system elements." While the Examiner cites "(see column 1 lines 60-65)" of the Downes reference, Applicant notes such portion merely recites "U.S. Pat. No. 4,339,657 describes a technique for error logging by integrating error

counts over a selected number of operations and comparing the results with a criterion. An exception is logged if the number of errors exceeds the criterion, but the exception log is cleared if the number of errors is less than the criterion." Applicant submits the cited portions of the cited reference fail to teach or suggest applying the "technique for error logging" mentioned in the Downes reference to "...each one of said protected system elements." Moreover, Applicant submits the cited portion of the cited reference appears to teach away from such modification, as Applicant submits the "technique for error logging" appears to discard its "exception log" when "the exception log is cleared." Furthermore, Applicant submits the Examiner's assertion that "Downes discloses the concept of predicting a failure..." is unsupported by the cited portion of the cited reference, as Applicant sees no disclosure of such "concept," and, moreover, claim 1 is not directed to a "concept."

Also, while the Examiner cites "(see column 6 lines 38-42)" of the Entenman reference as allegedly disclosing "in case of multiple failures, allotting a spare device among the devices in accordance with a priority algorithm," Applicant submits column 6, lines 35-38, refer to "the FIG. 1 arrangement" and refer to "a logic circuit 18 hierarchy," while column 6, lines 38-42, refers to "the arrangement of FIG. 2," "microprocessor controlled apparatus," "the spare modem," and "modules 10," and does not mention "in case of multiple failures." Thus, Applicant submits the Examiner alleges supposed teachings not found in the cited portion of the Entenman reference.

As another example, Applicant submits the cited portions of the cited references fail to disclose or suggest "identifying a failure predicted one of a plurality of protected system elements." While the Examiner cites "(see column 2 lines 19-23)" and "(see column 4 lines 23-27)," Applicant submits such portions merely recite "...monitoring the primary node of the computer system..." and "...determining whether the primary node is failing or about to fail...," not "...a plurality of protected system elements." Therefore, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to the subject matter of claim 1. Thus, Applicant submits claim 1 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 1 is in condition for allowance.

Regarding Claim 2, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 2. As an example, Applicant submits the cited portions of the cited references fail to disclose or suggest "wherein identifying the failure predicted one of said protected system elements includes assessing at least one of a plurality of failure prediction parameters of said protected system elements for determining when a failure prediction condition has been met by one of said protected system elements." While the Examiner cites "(see column 9 lines 15-20 of incorporated by reference Harper '266)," Applicant notes such portions merely recites "In single parameter monitoring, a rejuvenation agent monitors a small set of parameters and triggers rejuvenation when one or more of them approaches a predefined resource exhaustion threshold or characteristic hazardous value. This is effective for scenarios where a small number of primary indicators are found which reliably indicate resource exhaustion." Applicant submits such "monitoring" does not disclose or suggest "...identifying the failure predicted one of said protected system elements...," as Applicant sees no teaching or suggestion as to "...said protected system elements." Thus, Applicant submits claim 2 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 2 is in condition for allowance.

Regarding Claim 3, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 3. As an example, Applicant submits the cited portions of the cited references fail to disclose or suggest "correlating a present state of the failure prediction parameter to a failure prediction criterion for determining whether the failure prediction parameter has met a failure prediction condition." While the Examiner cites "(see column 9 lines 15-20 of incorporated by reference Harper '266)," Applicant submits the cited portion of the cited reference fails to disclose or suggest "...determining whether the failure prediction parameter has met a failure prediction condition," as Applicant sees no teaching or suggestion as to "...failure prediction condition" or even "...has met...." Thus, Applicant submits claim 3 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests

the Examiner consider such arguments. Therefore, Applicant submits claim 3 is in condition for allowance.

Regarding Claim 5, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 5. As one example, Applicant submits the cited portions of the cited references fail to disclose or suggest "wherein the monitoring the failure prediction parameter further comprises bridging the protection system element across the at least one of the plurality of the protected system elements." While the Examiner cites "(see column 6 lines 13-17)," Applicant submits such portion of the cited reference recites "...dynamic system updates...," which Applicant submits does not teach or suggest "...the monitoring the failure prediction parameter further comprising...." Thus, Applicant submits claim 5 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 5 is in condition for allowance.

Regarding Claim 6, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 6. As one example, Applicant submits the cited portions of the cited references fail to disclose or suggest "...wherein the monitoring the failure prediction parameter further comprises sequentially bridging the protection system element across each of the plurality of the protected system elements." While the Examiner cites "(see column 4 lines 23-27 and column 6 lines 13-17)," Applicant submits the cited portions of the cited reference do not disclose or suggest, for example, "...sequentially bridging..." or "...across each of the plurality of protected system elements." Thus, Applicant submits claim 6 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 6 is in condition for allowance.

Regarding Claim 10, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 10. Applicant has presented arguments for the allowability of

claim 1, from which claim 10 depends. Thus, Applicant submits claim 10 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 10 is in condition for allowance.

Regarding Claim 12, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 12. As an example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein the element demerit point level corresponds to a quantity of element demerit points accumulated over a designated period of time." While the Examiner cites "(see column 1 lines 60-65)" of the Downes reference, Applicant submits the cited portion of the cited reference fails to disclose or suggest, for example, "...over a designated period of time." Thus, Applicant submits claim 12 is in condition for allowance.

In the Examiner's Response to Arguments, the Examiner states, "The time is take to perform the selected number of operations constitutes the designated period of time." Applicant notes the Examiner does not cite any portion of any reference at allegedly disclosing or suggesting such teaching. Moreover, Applicant submits the Examiner does not explain how such "time" is alleged to be "designated." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 12. Therefore, Applicant submits claim 12 is in condition for allowance.

Regarding claim 13, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 13. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein identifying the failure predicted one of said protected system elements includes determining that a rate of change of element demerit points for one of said protected system elements has exceeded a predetermined element demerit point rate of change threshold limit." While the Examiner cites "(see column 1 lines 60-65)" of the Downes reference, Applicant submits the cited portion of the cited reference teaches away from the subject matter of claim 13. While claim 13 recites "...a rate of change of element demerit points...," Applicant notes the cited portion of the cited reference recites "...integrating error counts...." Thus, Applicant submits claim 13 is in condition for allowance.

In the Examiner's Response to Arguments, the Examiner states, "Downes discloses error logging by integrating error counts over a selected number of operations (see column 1 lines 60-65), indicating the claim limitation." However, Applicant submits the Examiner does not explain how "...integrating..." teaches "...determining that a rate of change of element demerit points...." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 13. Therefore, Applicant submits claim 13 is in condition for allowance.

Regarding Claim 14, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 14. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein identifying the failure predicted one of said protected system elements includes determining that a failure prediction parameter corresponding to a service agreement parameter for one of said protected system elements has declined to a predetermined minimal acceptable service agreement parameter level." While the Examiner cites "(see column 9 lines 10-15 and column 10 lines 12-15 of incorporated by reference Harper '266)," Applicant notes "column 10 lines 12-15" of the Harper '266 reference describe "paging traffic quiesces and CPU utilization falls to zero," neither of which Applicant considers to disclose "...a failure prediction parameter corresponding to a service agreement parameter for one of said protected system elements has declined to a predetermined minimal acceptable service agreement parameter level." Thus, Applicant submits claim 14 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 14 is in condition for allowance.

Regarding claim 15, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 15. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "determining that a protection switching priority among a collection of failure predicted system elements applies to the failure predicted one of said protected system elements." While the Examiner cites "(see column 6 lines 38-42)" of the Entenman reference as allegedly disclosing such subject matter, Applicant submits such portion of the cited reference fails to disclose, for example, "...applies to the failure predicted one of said protected system elements."

Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 15. Therefore, Applicant submits claim 15 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 15 is in condition for allowance.

Regarding claim 16, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 16. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein implementing the protection switching operation is initiated after determining that the protection switching priority applies to the failure predicted one of said protected system elements." While the Examiner cites "(see column 6 lines 38-42)" of the Entenman reference as allegedly disclosing such subject matter, Applicant submits such portion of the cited reference fails to disclose, for example, "...is initiated after determining that the protection switching priority applies to the failure predicted one of said protected system elements." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 16. Therefore, Applicant submits claim 16 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 16 is in condition for allowance.

Regarding claim 17, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 17. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein determining that the protection switching priority applies to the failure predicted one of said protected system elements includes assessing a protection switching priority parameter for each system element of the collection of failure predicted system elements." While the Examiner cites "(see column 6 lines 38-42)" of the Entenman reference as allegedly disclosing such subject matter, Applicant submits such portion of the cited reference fails to disclose, for example, "...includes assessing a protection switching priority parameter for each system element of the collection of failure predicted system elements." Thus, Applicant submits the Examiner

has not made a *prima facie* showing of obviousness with respect to claim 17. Therefore, Applicant submits claim 17 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 17 is in condition for allowance.

Regarding claim 18, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 18. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein assessing the protection switching parameter includes assessing at least one of a parameter relating to element demerit points, a parameter relating to a rate of change of said element demerit points, a parameter relating to an element demerit point threshold limit, a parameter relating to a number of active connections, a parameter relating to a number of active service subscribers, a parameter designated in a service agreement, a mounted position in a network element, an administrator-assigned priority value, a data bit rate and a rate of change of the data bit rate." While the Examiner cites "(see column 1 lines 60-65)" of the Downes reference as allegedly disclosing such subject matter, Applicant submits such portion of the cited reference fails to disclose, for example, "...assessing the protection switching parameter...." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 18. Therefore, Applicant submits claim 18 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 18 is in condition for allowance.

Regarding Claim 19, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 19. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "downloading service information of the failure predicted one of said protected system elements to the protection system element after identifying the failure predicted one of said protected system elements." As Applicant noted with respect to claim 1, from which claim 19 depends, Applicant submits the cited portion of the cited reference fails to teach or

suggest "identifying a failure predicted one of a plurality of protected system elements." Thus, Applicant submits claim 19 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 19 is in condition for allowance.

Regarding claim 20, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 20. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "determining that a protection switching priority among a collection of failure predicted system elements applies to the failure predicted one of said protected system elements." While the Examiner cites "(see column 6 lines 38-42)" of the Entenman reference as allegedly disclosing such subject matter, Applicant submits such portion of the cited reference fails to disclose, for example, "...applies to the failure predicted one of said protected system elements." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 20. Therefore, Applicant submits claim 20 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 20 is in condition for allowance.

Regarding claim 21, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 21. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "wherein determining that the protection switching priority applies to the failure predicted one of said protected system elements includes assessing a protection switching priority parameter for the collection of failure predicted system elements." While the Examiner cites "(see column 6 lines 38-42)" of the Entenman reference as allegedly disclosing such subject matter, Applicant submits such portion of the cited reference fails to disclose, for example, "...includes assessing a protection switching priority parameter for the collection of failure predicted system elements." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 21. Therefore, Applicant submits claim 21 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 21 is in condition for allowance.

Regarding claim 22, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 22. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "wherein assessing the protection switching parameter includes assessing at least one of a parameter relating to element demerit points, a parameter relating to a rate of change of said element demerit points, a parameter relating to an element demerit point threshold limit, a parameter relating to a number of active connections, a parameter relating to a number of active service subscribers, a parameter designated in a service agreement, a mounted position in a network element, an administrator-assigned priority value, a data bit rate and a rate of change of the data bit rate." While the Examiner cites "(see column 1 lines 60-65)" of the Downes reference as allegedly disclosing such subject matter, Applicant submits such portion of the cited reference fails to disclose, for example, "...assessing the protection switching parameter." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 22. Therefore, Applicant submits claim 22 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 22 is in condition for allowance.

Regarding Claim 23, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 23. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein the protection system element provides protection switching functionality exclusively for all of said protected system elements." While the Examiner cites "(see column 6 lines 35-40)" of the Harper '398 reference, Applicant notes col. 6, lines 21-25, of the cited reference states, "...at which time the secondary node becomes the primary node, and the primary node is rebooted and subsequently becomes the secondary node." Applicant submits such teaching teaches away from the subject matter of claim 23. Thus, Applicant submits claim 23 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 23 is in condition for allowance.

Regarding Claim 27, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 27. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein identifying the failure predicted one of said protected system elements includes determining that a failure prediction parameter associated with the failure predicted one of said protected system elements has exceeded a failure prediction parameter first threshold limit." While the Examiner cites "(see column 9 lines 6-10 and 25-28 of incorporated by reference Harper '266)," Applicant notes col. 9, lines 25-28, of the Harper '266 reference states "FIG. 7 illustrates, for example, the growth in consumption over time of a typical resource (e.g., non-paged pool bytes), toward an upper limit." Applicant submits the cited portion of the cited reference fails to disclose "...has exceeded a failure prediction parameter first threshold limit." Thus, Applicant submits claim 27 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 27 is in condition for allowance.

Regarding Claim 29, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 29. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein the protection system element provides protection switching functionality exclusively for all of said protected system elements." While the Examiner cites "(see column 6 lines 35-37)" of the Harper '398 reference, Applicant submits col. 6, lines 21-25, of the cited reference states, "...at which time the secondary node becomes the primary node, and the primary node is rebooted and subsequently becomes the secondary node." Applicant submits such teaching teaches away from the subject matter of claim 29. Thus, Applicant submits claim 29 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests

the Examiner consider such arguments. Therefore, Applicant submits claim 29 is in condition for allowance.

Regarding Claim 30, Applicant has submitted arguments for the allowability of claim 1, from which claim 30 depends. Thus, Applicant submits claim 30 is also in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 30 is in condition for allowance.

Regarding Claim 31, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 31. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...specifying failure prediction criterion for each of said protected system elements." While the Examiner cites "(see column 9 lines 7-14 of incorporated by reference Harper '266)," Applicant submits such portion of such reference fails to disclose or suggest, for example, "...for each of said protected system elements." Thus, Applicant submits claim 31 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 31 is in condition for allowance.

Regarding Claim 32, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 32. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein specifying said failure prediction criterion includes specifying a first type of failure prediction criterion for a first portion of said protected system elements and a second type of failure prediction criterion for a second portion of said protected system elements." While the Examiner cites "(see column 9 lines 6-10 of incorporated by reference Harper '266)," Applicant submits the cited portion of the cited reference does not teach or suggest, for example, "...a first portion of said protected system elements..." and "...a second portion of said protected system elements." Thus, Applicant submits claim 32 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 32 is in condition for allowance.

Regarding Claim 33, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 33. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein specifying said failure prediction criterion includes specifying said failure prediction criterion on a per protected system element basis." While the Examiner cites "(see column 4 lines 10-15 and column 6 lines 32-37 and column 9, lines 7-14 of Harper '266)," Applicant submits the cited portions of the cited reference fail to teach or suggest, for example, "...specifying said failure prediction criterion...." Thus, Applicant submits claim 33 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 33 is in condition for allowance.

Regarding Claim 35, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 35. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "...wherein identifying the failure predicted one of said protected system elements includes assessing a protection switching operation initiation notification issued via a system administrator user interface." While the Examiner cites, "see column 4 lines 20-22 of incorporated by reference Harper '266)," Applicant submit the cited portion of the cited reference recites "...the system operator can...initiate a graceful planned outage...," which Applicant submits fails to teach or suggest the subject matter of claim 35. Thus, Applicant submits claim 35 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 35 is in condition for allowance.

Regarding claim 36, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 36. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "downloading service information of the failure predicted one of said protected system elements to the protection system element after identifying the failure predicted one of said protected system elements." As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "downloading service information of the failure predicted one of said protected system elements to the protection system element after identifying the failure predicted one of said protected system elements." As Applicant noted with respect to claim 1, from which claim 36 indirectly depends, Applicant submits the cited portion of the cited reference fails to teach or suggest "identifying a failure predicted one of a plurality of protected system elements." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 36. Therefore, Applicant submits claim 36 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 36 is in condition for allowance.

With respect to claim 38, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper is concerned with detecting degradation of performance of a computer system (see column 1 lines 60-65), and monitoring the error count over a selected number of operations, as per teachings of Downes (see column 1 lines 60-65), constitutes as suitable known means to detect degradation of performance of a computer system." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342, Harper et al. '398, and Downes et al. '761 references, Applicant notes the Harper et al. '398 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to

render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has not cited any portion of any of the cited references with respect to the Examiner's allegation of "...to detect degradation of performance of a computer system." Furthermore, while the Examiner cites "(see column 1 lines 60-65)" as to "Harper is concerned with detecting degradation of performance of a computer system," Applicant sees no teaching as to "detecting..." in the cited portion of the cited reference. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 38.

Regarding claim 38, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 38. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "wherein correlating includes determining that an element demerit point level of one of said protected system elements has exceeded a predetermined element demerit point threshold limit." While the Examiner cites "(see column 1 lines 60-65)" of the Downes reference, Applicant notes such portion merely recites "U.S. Pat. No. 4,339,657 describes a technique for error logging by integrating error counts over a selected number of operations and comparing the results with a criterion. An exception is logged if the number of errors exceeds the criterion, but the exception log is cleared if the number of errors is less than the criterion." Applicant submits the cited portions of the cited reference fail to teach or suggest applying the "technique for error logging" mentioned in the Downes reference to "...one of said protected system elements." Moreover, Applicant submits the cited portion of the cited reference appears to teach away from such modification, as Applicant submits the "technique for error logging" appears to discard its "exception log" when "the exception log is cleared." Furthermore, Applicant submits the Examiner's assertion that "Downes discloses the concept of predicting a failure..." is unsupported by the cited portion of the cited reference, as Applicant sees no disclosure of such "concept," and, moreover, claim 38 is not directed to a "concept." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 38. Therefore, Applicant submits claim 38 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 38 is in condition for allowance.

Regarding claim 40, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 40. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "wherein the element demerit point level corresponds to a quantity of element demerit points accumulated over a designated period of time." While the Examiner cites "(see column 1 lines 60-65)" of the Downes reference as allegedly disclosing such subject matter, Applicant submits such portion of the cited reference fails to disclose, for example, "...accumulated over a designated period of time" Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 40. Therefore, Applicant submits claim 40 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 40 is in condition for allowance.

With respect to claim 41, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper is concerned with detecting degradation of performance of a computer system (see column 1 lines 60-65), and monitoring the error count over a selected number of operations, as per teachings of Downes (see column 1 lines 60-65), constitutes as suitable known means to detect degradation of performance of a computer system." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342, Harper et al. '398, and Downes et al. '761 references, Applicant notes the Harper et al. '398 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has not cited any portion of any of the cited references with respect to the Examiner's allegation of "...to detect degradation of performance of a computer

system." Furthermore, while the Examiner cites "(see column 1 lines 60-65)" as to "Harper is concerned with detecting degradation of performance of a computer system," Applicant sees no teaching as to "detecting..." in the cited portion of the cited reference. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 41.

Regarding claim 41, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 41. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "wherein correlating includes determining that a rate of change of element demerit points for one of said protected system elements has exceeded a predetermined element demerit point rate of change threshold limit." While the Examiner cites "(see column 1 lines 60-65)" of the Downes reference as allegedly disclosing such subject matter, Applicant submits such portion of the cited reference fails to disclose, for example, "...has exceeded a predetermined element demerit point rate of change threshold limit." Furthermore, Applicant submits the Examiner's assertion that "Downes discloses the concept of predicting a failure..." is unsupported by the cited portion of the cited reference, as Applicant sees no disclosure of such "concept," and, moreover, claim 41 is not directed to a "concept." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 41. Therefore, Applicant submits claim 41 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 41 is in condition for allowance.

With respect to claim 43, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper is concerned with detecting degradation of performance of a computer system (see column 1 lines 60-65), and monitoring the error count over a selected number of operations, as per teachings of Downes (see column 1 lines 60-65), constitutes as suitable known means to detect degradation of performance of a computer system." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on

alleged teachings of the Entenman '342, Harper et al. '398, and Downes et al. '761 references, Applicant notes the Harper et al. '398 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has not cited any portion of any of the cited references with respect to the Examiner's allegation of "...to detect degradation of performance of a computer system." Furthermore, while the Examiner cites "(see column 1 lines 60-65)" as to "Harper is concerned with detecting degradation of performance of a computer system," Applicant sees no teaching as to "detecting..." in the cited portion of the cited reference. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 43.

Regarding claim 43, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 43. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "wherein determining that the protection switching priority applies to the failure predicted one of said protected system elements includes assessing at least one of a parameter relating to element demerit points, a parameter relating to a rate of change of said element demerit points, a parameter relating to an element demerit point threshold limit, a parameter relating to a number of active connections, a parameter relating to a number of active service subscribers, a parameter designated in a service agreement, a mounted position in a network element, an administrator-assigned priority value, a data bit rate and a rate of change of the data bit rate." While the Examiner cites "(see column 1 lines 60-65)" of the Downes reference as allegedly disclosing such subject matter, Applicant submits such portion of the cited reference fails to disclose, for example, "...determining that the protection switching priority applies to the failure predicted one of said protected system elements...." Furthermore, Applicant submits the Examiner's assertion that "Downes discloses the concept of predicting a failure..." is unsupported by the cited portion of the cited reference, as Applicant sees no disclosure of such "concept," and, moreover, claim 43 is not directed to a "concept." Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 43. Therefore, Applicant submits claim 43 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response to Applicant's previously submitted arguments. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 43 is in condition for allowance.

The Examiner has rejected claims 11, 24-26, 28, and 39 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,978,398 of Harper '398 in view of U.S. Patent No. 4,245,342 of Entenman and US Patent No. 4,769,761 of Downes et al., and further in view of US Patent No. 6,771,440 of Smith.

With respect to claims 11 and 39, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper discloses a first threshold that predicts a failure is to follow (see column 9 lines 7-14 and lines 25-30 of incorporated by reference Harper '266) and is further concerned with signifying a system element has failed (see column 6 lines 5-25) and having a second threshold that signifies a failure, as per teachings of Smith (see column 6 lines 6-20), provides a known and suitable means to signifying the system element has failed." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342, Harper et al. '398, Downes et al. '761, and Smith '440 references, Applicant notes the Smith '440 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has alleged motivation only as to combining "the teachings" of "Harper,...as per teachings of Smith," but has not alleged motivation to combine alleged teachings of all of the cited references. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claims 11 and 39.

In the Examiner's Response to Arguments, the Examiner refers, without citing a claim number, to "applicant's argument that prior art is nonanalogous art. As the Examiner refers to "(see page 32)," which Applicant understands to be a page number of Applicant's response to the previous non-final Office action, Applicant understands the Examiner is referring to Applicant's argument with respect to at least claims 11 and 24. However, Applicant alleged the Smith reference to be non-analogous art with respect to other claims as well, so Applicant directs argument to all claims for which the Examiner relied upon the Smith reference in making rejections. While the Examiner states, "In this case, both prior art references are directed to utilizing thresholds for determining failure." Applicant notes the Examiner relies on "Harper '398 (which incorporates by reference Harper '266) in view of Entenman, Downes, and US Patent No. 6,771,440 of Smith in rejecting claims 11, 24-26, 28, and 39. Thus, Applicant submits the Examiner's reference to "both prior art references" appears to mischaracterize the references upon which the Examiner relies. Moreover, Applicant notes the Smith reference is actually directed to "...a method of operating a disk drive includes detecting a trigger even during non-idle operation of the disk drive, and responding to the detected trigger event by performing a predictive failure analysis with respect to the disk drive" and "...a method of operating a disk drive includes performing a predictive failure analysis with respect to the disk drive at a regular time interval, detecting a trigger event during non-idle operation of the disk drive, and responding to the detected trigger event by reducing the regular time interval at which the predictive failure analysis is performed," as recited in the abstract. Applicant submits the Examiner has not shown the other references upon which the Examiner relies to be directed to a method of operating a disk drive and has not shown the claimed subject matter of the claims for which the Examiner relied upon the Smith reference to bring a rejection as being directed to a method of operating a disk drive. Thus, Applicant submits the Smith reference is non-analogous art. Therefore, Applicant submits all claims for which the Examiner relied upon the Smith reference to bring a rejection are in condition for allowance.

In the Examiner's Response to Arguments, the Examiner refers, without citing a claim number, to "...applicant's argument that the examiner's rejection is inconsistent with MPEP (see pages 32 and 33)...." While the Examiner states "...there have been numerous amendments, which has changed the scope of the claims, and the additional prior art has be introduced, which may have change the possible combinations used for a rejection." However, Applicant notes claims 11 and 39 appear to be in the same form as they were originally filed, and, as Applicant previously stated, Applicant notes the Examiner cited the Smith reference on the Form PTO-892 enclosed with the first Office action, where

the Examiner characterized claims 11 and 39 as "Allowable Subject Matter" and stated claims 11 and 39 were "objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Moreover, it is the Smith reference that the Examiner cites with respect to both claims 11 and 39. Therefore, Applicant submits the Examiner's comments are moot with respect to the history of claims 11 and 39 and the Smith reference. Also, while the Examiner states, "...such arguments fail to specifically pointing out how the language of the claims patentably distinguishes them from the references," Applicant notes Applicant presented additional argument with respect to claims 11 and 39 in response to the previous non-final Office action. Thus, Applicant submits claims 11 and 39 are in condition for allowance.

Regarding claim 11, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 11. As one example, Applicant submits the cited references fail to teach or suggest "...wherein the predetermined element demerit point threshold limit is associated with a first level of failure probability, lower than an element demerit point threshold limit corresponding to a next higher level of failure probability." While the Examiner cites, "(see column 6 lines 6-20)" of the Smith reference, Applicant submits the Smith reference pertains to adaptive event-based predictive analysis measurements in a hard disk drive. Accordingly, Applicant submits the Smith reference is non-analogous art. Moreover, Applicant notes the Examiner cited the Smith reference on the Form PTO-892 enclosed with the first Office action, where the Examiner characterized claim 11 as "Allowable Subject Matter" and stated claim 11 was "objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Applicant notes MPEP § 706.04 "Rejection of Previously Allowed Claims" states as follows:

> A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.
>
> Great care should be exercised in authorizing such a rejection. See *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); *Ex parte Hay*, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909).

Accordingly, Applicant submits the Examiner's rejection appears to be inconsistent with MPEP § 706.04. Furthermore, Applicant has presented arguments for the allowability of claims 1, from which claim 11 depends. Thus, Applicant submits claim 11 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response designated as pertaining to claim 11. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 11 is in condition for allowance.

Regarding claim 39, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 39. As one example, Applicant submits the cited references fail to teach or suggest "...wherein the predetermined element demerit point threshold limit is associated with a first level of failure probability, lower than an element demerit point threshold limit corresponding to a next higher level of failure probability." While the Examiner cites, "(see column 6 lines 6-20)" of the Smith reference, Applicant submits the Smith reference pertains to adaptive event-based predictive analysis measurements in a hard disk drive. Accordingly, Applicant submits the Smith reference is non-analogous art. Moreover, Applicant notes the Examiner cited the Smith reference on the Form PTO-892 enclosed with the first Office action, where the Examiner characterized claim 39 as "Allowable Subject Matter" and stated claim 39 was "allowable over the prior art of records." Applicant notes MPEP § 706.04 "Rejection of Previously Allowed Claims" states as follows:

> A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.
>
> Great care should be exercised in authorizing such a rejection. See *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); *Ex parte Hay*, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909).

Accordingly, Applicant submits the Examiner's rejection appears to be inconsistent with MPEP § 706.04. Furthermore, Applicant has presented arguments for the allowability of claims 1, from which claim 39 depends. Therefore, Applicant submits claim 39 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response designated as pertaining to claim 39. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 39 is in condition for allowance.

With respect to claim 24, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper discloses a first threshold that predicts a failure is to follow (see column 9 lines 7-14 and lines 25-30 of incorporated by reference Harper '266) and is further concerned with signifying a system element has failed (see column 6 lines 5-25) and having a second threshold that signifies a failure, as per teachings of Smith (see column 6 lines 6-20), provides a known and suitable means to signifying the system element has failed." While the

Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342, Harper et al. '398, Downes et al. '761, and Smith '440 references, Applicant notes the Smith '440 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has alleged motivation only as to combining "the teachings" of "Harper,...as per teachings of Smith," but has not alleged motivation to combine alleged teachings of all of the cited references. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 24.

As to claim 24, Applicant notes the Smith reference pertains to adaptive event-based predictive analysis measurements in a hard disk drive. Accordingly, Applicant submits the Smith reference is non-analogous art. Moreover, Applicant has presented arguments for the allowability of claims 1 and 19, from which claim 24 depends. Thus, Applicant submits claim 24 is also in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response designated as pertaining to claim 24. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 24 is in condition for allowance.

As to claim 25, Applicant notes the Smith reference pertains to adaptive event-based predictive analysis measurements in a hard disk drive. Accordingly, Applicant submits the Smith reference is non-analogous art. Moreover, Applicant has presented arguments for the allowability of claims 1 and 19, from which claim 25 indirectly depends. Thus, Applicant submits claim 25 is also in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response designated as pertaining to claim 25. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 25 is in condition for allowance.

With respect to claim 26, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper discloses a first threshold that predicts a failure is to follow (see column 9 lines 7-14 and lines 25-30 of incorporated by reference Harper '266) and is further concerned with signifying a system element has failed (see column 6 lines 5-25) and having a second threshold that signifies a failure, as per teachings of Smith (see column 6 lines 6-20), provides a known and suitable means to signifying the system element has failed." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342, Harper et al. '398, Downes et al. '761, and Smith '440 references, Applicant notes the Smith '440 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has alleged motivation only as to combining "the teachings" of "Harper,...as per teachings of Smith," but has not alleged motivation to combine alleged teachings of all of the cited references. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 26.

As to claim 26, Applicant notes the Smith reference pertains to adaptive event-based predictive analysis measurements in a hard disk drive. Accordingly, Applicant submits the Smith reference is non-analogous art. Moreover, Applicant has presented arguments for the allowability of claims 1 and 19, from which claim 26 depends. Thus, Applicant submits claim 26 is also in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response designated as pertaining to claim 26. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 26 is in condition for allowance.

With respect to claim 28, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper discloses a first threshold that predicts a failure is to follow (see column 9 lines 7-14 and lines 25-30 of incorporated by reference Harper '266) and is further concerned with signifying a system element has failed (see column 6 lines 5-25) and having a second threshold that signifies a failure, as per teachings of Smith (see column 6 lines 6-20), provides a known and suitable means to signifying the system element has failed." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342, Harper et al. '398, Downes et al. '761, and Smith '440 references, Applicant notes the Smith '440 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has alleged motivation only as to combining "the teachings" of "Harper,...as per teachings of Smith," but has not alleged motivation to combine alleged teachings of all of the cited references. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 28.

As to claim 28, the Examiner states, "Smith discloses a system wherein a first threshold triggers a predictive failure analysis and a second threshold greater than the first threshold signifies a failure (see column 6 lines 6-20)." However, Applicant submits such alleged teaching does not describe "...implementing said protection switching operation...." Thus, Applicant submits claim 28 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response designated as pertaining to claim 28. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 28 is in condition for allowance.

The Examiner has rejected claim 53 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,978,398 of Harper '398 in view of U.S. Patent No. 4,245,342 of Entenman and of US Patent No. 6,771,440 of Smith.

With respect to claim 53, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper discloses a first threshold that predicts a failure is to follow (see column 9 lines 7-14 and lines 25-30 of incorporated by reference Harper '266) and is further concerned with signifying a system element has failed (see column 6 lines 5-25) and having a second threshold that signifies a failure, as per teachings of Smith (see column 6 lines 6-20), provides a known and suitable means to signifying the system element has failed." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342, Harper et al. '398, Downes et al. '761, and Smith '440 references, Applicant notes the Smith '440 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010). As an example, Applicant submits the Examiner has alleged motivation only as to combining "the teachings" of "Harper,...as per teachings of Smith," but has not alleged motivation to combine alleged teachings of all of the cited references. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 53.

Regarding claim 53, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 53. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "identifying the failure predicted one of said protected system

elements includes determining that a failure prediction parameter associated with the failure predicted one of said protected system elements has exceeded a failure prediction parameter first threshold limit." While the Examiner cites "(see column 6 lines 6-20)" of the Smith reference as allegedly disclosing "a system wherein a first threshold triggers a predictive failure analysis and a second threshold greater than the first threshold signifies a failure," Applicant submits such alleged teaching, specifically "wherein a first threshold triggers a predictive failure analysis," teaches away from the subject matter of claim 53. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 53. Therefore, Applicant submits claim 53 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response designated as pertaining to claim 53. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 53 is in condition for allowance.

The Examiner has rejected claim 54 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,978,398 of Harper '398 in view of U.S. Patent No. 4,769,761 of Downes et al.

With respect to claim 54, the Examiner alleges "A person of ordinary skill in the art could have been motivated to combine the teachings because Harper is concerned with detecting degradation of performance of a computer system (see column 1 lines 60-65), and monitoring the error count over a selected number of operations, as per teachings of Downes (see column 1 lines 60-65), constitutes as suitable known means to detect degradation of performance of a computer system." While the Examiner alleges various teachings with respect to different references, even assuming arguendo the merit of the Examiner's allegations, Applicant submits "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements is, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405, 418 (2007). While the Examiner the relies on alleged teachings of the Entenman '342, Harper et al. '398, and Downes et al. '761 references, Applicant notes the Harper et al. '398 reference is classified in different U.S. classifications and appears to have been subjected to mutually exclusive fields of search as compared to the Entenman '342 and Downes et al. '761 references. Thus, Applicant submits one of ordinary skill in the art would not have been led to attempt to combine the alleged teachings. Applicant submits the Examiner has not provided a plausible rationale as to why the prior art references would have worked together to render the claims obvious. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010).

As an example, Applicant submits the Examiner has not cited any portion of any of the cited references with respect to the Examiner's allegation of "...to detect degradation of performance of a computer system." Furthermore, while the Examiner cites "(see column 1 lines 60-65)" as to "Harper is concerned with detecting degradation of performance of a computer system," Applicant sees no teaching as to "detecting..." in the cited portion of the cited reference. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to claim 54.

Regarding claim 54, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 54. As one example, Applicant submits the cited portions of the cited references fail to teach or suggest "identifying a failure predicted one of a plurality of protected system elements." While the Examiner cites, "(see column 2 lines 19-23)" and "(see column 4 lines 23-27)" of the Harper '398 reference, Applicant submits the cited portions of the cited reference recite "In a third aspect, a method (and system) of maintaining performance of a primary node in a computer system, includes monitoring the primary node of the computer system, determining whether the primary node is failing or about to fail, and migrating the state of the primary node to..." and "Indeed, in a cluster system having more than two nodes, the secondary node 101B may not know which primary node 101A is going to fail until the failure is predicted, so it cannot have the primary node's application already running." As another example, Applicant submits such portion of such reference fails to teach or suggest, for example, "a plurality of protected system elements." Rather, Applicant submits col. 2, lines 19-23, of the cited reference, as cited by the Examiner, appears to describe merely "...monitoring the primary node..., determining whether the primary node is failing or is about to fail...." Thus, Applicant submits claim 54 is in condition for allowance.

Regarding claim 54, Applicant submits the cited portions of the cited references fail to render obvious the subject matter of claim 54. In the Examiner's Response to Arguments, the Examiner states as follows:

> In response to teaching away, examiner is uncertain how the 'technique for error logging' appears to discard its 'exception log' when 'the exception log is cleared' causes the reference to teach away from such modification. Harper is concerned with detecting degradation of performance of a computer system (see column 1 lines 60-61), and a person of ordinary skill in the art could have been motivated to combine the teachings because monitoring the error count over a selected number of operations, as per teachings of Downes (see column 1 lines 60-65), constitutes as suitable known means to detect degradation of performance of a computer system. Argument is moot. Examiner maintains his rejection.

Applicant submits Downes' teaching as to clearing the "exception log" appears to delete the "error counts." Applicant submits, while the Examiner alleges "Downes discloses the concept of predicting a failure upon determination the error count over a selected number of operations is above a criterion or threshold (see column 1 lines 60-65)," deleting the "error counts" upon which Downes apparently depends would prevent "determining the rate of change of element demerit points..." even if the teachings of the cited portion of the Downes reference did disclose the subject matter alleged by the Examiner, which Applicant disputes.

As Applicant previously stated, as one example, Applicant submits the cited portions of the cited references fail to teach or suggest "identifying a failure predicted one of a plurality of protected system elements." While the Examiner cites, "(see column 2 lines 19-23)" and "(see column 4 lines 23-27)" of the Harper '398 reference, Applicant submits the cited portions of the cited reference recite "In a third aspect, a method (and system) of maintaining performance of a primary node in a computer system, includes monitoring the primary node of the computer system, determining whether the primary node is failing or about to fail, and migrating the state of the primary node to..." and "Indeed, in a cluster system having more than two nodes, the secondary node 101B may not know which primary node 101A is going to fail until the failure is predicted, so it cannot have the primary node's application already running." As another example, Applicant submits such portion of such reference fails to teach or suggest, for example, "a plurality of protected system elements." Rather, Applicant submits col. 2, lines 19-23, of the cited reference, as cited by the Examiner, appears to describe merely "...monitoring the primary node..., determining whether the primary node is failing or is about to fail...." Thus, Applicant submits claim 54 is in condition for allowance.

In the Examiner's Response to Arguments, Applicant sees no response designated as pertaining to claim 54. Thus, Applicant reiterates such arguments and respectfully requests the Examiner consider such arguments. Therefore, Applicant submits claim 54 is in condition for allowance.

Without referencing any particular claim, the Examiner states, in the Examiner's Response to Arguments, "In response to applicant's arguments against the references individually (see page 21 and 22), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)." As Applicant's argument on pages 21 and 22 of Applicant's response to the preceding non-final Office action appears to have pertained to

claims 1, 2, and 3, Applicant understands the Examiner's assertion to pertain to such claims and responds with respect to such claims.

With respect to claim 1, Applicant notes the Examiner alleges "Downes further discloses the concept of predicting a failure upon determination the error count over a selected number of operations is above a criterion or threshold (see column 1 lines 60-65), apparently to allege teaching or suggestion of "wherein identifying the failure predicted one of said protected system elements includes assessing performance of said protected system elements based at least partially on an element demerit point level of each one of said protected system elements." Applicant notes the Examiner expressly states that Harper '398 fails to explicitly disclose such feature. Applicant submits the Examiner does not appear to allege that Entenman discloses such feature. Rather, as discussed above, Applicant submits the Examiner appear to rely solely on the Downes reference to allege teaching or suggestion of, for example, "...based at least partially on an element demerit point level of each one of said protected system elements." Thus, Applicant presented argument to counter that apparent allegation. Accordingly, Applicant submits that none of the cited references relied upon by the Examiner teach or suggest, for example, "...based at least partially on an element demerit point level of each one of said protected system elements." Thus, any combination of the cited references relied upon by the Examiner, assuming arguendo such combination is properly made in accordance with U.S. patent law, fails to teach or suggest, for example, "...based at least partially on an element demerit point level of each one of said protected system elements." Applicant's argument is therefore made directly toward the combination of the references, requiring analysis of the teachings of each constituent reference of the combination individually. Therefore, Applicant submits the Examiner has not shown the combination of references to render unpatentable the subject matter of claim 1.

With respect to claim 2, Applicant notes the Examiner cites only "(see column 9 lines 15-20 of incorporated reference Harper '266)" as allegedly teaching or suggesting "wherein identifying the failure predicted one of said protected system elements includes assessing at least one of a plurality of failure prediction parameters of said protected system elements for determining when a failure prediction condition has been met by one of said protected system elements." Thus, Applicant presented argument to counter that apparent allegation. Applicant notes the Examiner does not appear to allege teaching or suggestion of such subject matter in any of the other cited references. Accordingly, Applicant submits that none of the cited references relied upon by the Examiner teach or suggest, for example, "wherein identifying the failure predicted one of said protected system elements

includes assessing at least one of a plurality of failure prediction parameters of said protected system elements for determining when a failure prediction condition has been met by one of said protected system elements." Thus, any combination of the cited references relied upon by the Examiner, assuming arguendo such combination is properly made in accordance with U.S. patent law, fails to teach or suggest, for example, "wherein identifying the failure predicted one of said protected system elements includes assessing at least one of a plurality of failure prediction parameters of said protected system elements for determining when a failure prediction condition has been met by one of said protected system elements." Applicant's argument is therefore made directly toward the combination of the references, requiring analysis of the teachings of each constituent reference of the combination individually. Therefore, Applicant submits the Examiner has not shown the combination of references to render unpatentable the subject matter of claim 2.

With respect to claim 3, Applicant notes the Examiner cites only "(see column 9 lines 15-20 of incorporated reference Harper '266)" as allegedly teaching or suggesting "monitoring a failure prediction parameter of at least one of the plurality of protected system elements" and also cites only the same portion of the same reference as allegedly teaching or suggesting "correlating a present state of the failure prediction parameter to a failure prediction criterion for determining whether the failure prediction parameter has met a failure prediction condition.." Thus, Applicant presented argument to counter those apparent allegations. Applicant notes the Examiner does not appear to allege teaching or suggestion of such subject matter in any of the other cited references. Accordingly, Applicant submits that none of the cited references relied upon by the Examiner teach or suggest either of the cited portions of the subject matter of claim 3. Thus, any combination of the cited references relied upon by the Examiner, assuming arguendo such combination is properly made in accordance with U.S. patent law, fails to teach or suggest either of cited portions of the subject matter of claim 3. Applicant's argument is therefore made directly toward the combination of the references, requiring analysis of the teachings of each constituent reference of the combination individually. Therefore, Applicant submits the Examiner has not shown the combination of references to render unpatentable the subject matter of claim 3.

In the Examiner's Response to Arguments, the Examiner refers, without citing a claim number, to "...applicant's arguments, 'deleting the 'error counts' upon which Downes apparently depends would prevent 'determining the rate of change of element demerit points...' even if the teachings of the cited portion of the Downes reference did disclose the subject matter alleged by the Examiner, which

Applicant disputes,' (see page 17 of Remarks)...." However, Applicant does not see such argument on "page 17 of Remarks." While the Examiner states, "Downes discloses the exception log, not error count is cleared (see column 1 lines 65)," Applicant submits column 1, line 65, of the Downes references recites "An exception is logged if the number of errors exceeds the criterion, but the exception log is cleared if the number of errors is less than the criterion." Applicant submits such portion of the Downes reference contradicts the Examiner's assertion. Applicant submits the Examiner fails to show how "...integrating..." "constitutes 'a rate of change of demerit points,'..." as alleged by the Examiner. Thus, Applicant submits the Examiner has not made a *prima facie* showing of obviousness with respect to subject matter to which Applicant's arguments refer, but which the Examiner did not cite by claim number.

In the Examiner's Response to Arguments, the Examiner refers, without citing claim numbers, to "applicant's argument pertaining to the remaining claims...." The Examiner states, "...such arguments are either directed to similar arguments presented above or fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references." As the Examiner has not identified any claim numbers of claims which the Examiner refers to as "the remaining claims" (and the Examiner did not identify claim numbers of some claims which the Examiner would not characterize as "the remaining claims"), it is not possible for Applicant to know what claims the Examiner is referring to as "the remaining claims." Nonetheless, for some claims, Applicant has alleged that the Examiner has not made a *prima facie* showing in bringing purported rejections, in which case Applicant submits Applicant need not specifically point out how the language of the claims patentably distinguishes them from the references, as Applicant submits Applicant is presumptively entitled to allowability of claims if the Examiner does not make a *prima facie* showing of a valid ground of rejection. Thus, Applicant submits "the remaining claims," whichever claims the Examiner may consider them to be, are allowable.

In conclusion, Applicant has overcome all of the Office's rejections, and early notice of allowance to this effect is earnestly solicited. If, for any reason, the Office is unable to allow the Application on the next Office Action, and believes a telephone interview would be helpful, the Examiner is respectfully requested to contact the undersigned attorney.

Respectfully submitted,

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Date

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